

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 1-31 were previously pending and remain pending in this application, with claims 22-31 having been withdrawn from consideration in response to a previously filed response to restriction requirement.

Claims 1-21 were examined and rejected. Claims 5 and 6 were objected to as being dependent on a rejected base claim, but were otherwise indicated to be allowable.

No amendments have been made herein. No new matter has been added.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

**Rejections Under 35 U.S.C. §102**

Claims 1-4 and 7-9 were rejected under 35 U.S.C. §102(b) as being anticipated by Brennan et al. (U.S. Patent No. 6,076,013). Other than the generalized statement put forth by the Examiner in the context of the rejection of claims 10-21 under 35 U.S.C. §103(a) that “Brennan discloses an apparatus and method for treating heart failure that shows many of the features of the claimed invention...”, the Examiner has not particularly identified any structural components disclosed in Brennan et al. that are equivalent to the claimed elements of the present invention.

Applicants respectfully submit that it is incumbent upon the Examiner to put forth the basis and reasoning for a claim rejection. MPEP 706.02(i) requires an Examiner to identify “the particular part of the reference relied upon to support the rejection.” Moreover, 35 U.S.C. §132(a) states that “[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.” Applicants respectfully submit that the Office Action does not provide sufficient reasons, support or information upon which the Applicant can address the rejection.

Notwithstanding the above, Applicants have reviewed Brennan et al. and find no disclosure, suggestion or teaching of a heart support structure comprising at least one peripheral link configured for attachment to at least one region of viable heart tissue; and at least one support link having a proximal end and a distal end, the proximal end configured for attachment to the peripheral link, the support link

extendable to and configured for attachment to a second region of less viable or non-viable heart tissue. For at least this reason, Brennan et al. does not anticipate the subject matter of claims 1-4 and 7-9.

Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

### **Rejections Under 35 U.S.C. §103**

Claims 10-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brennan et al. in view of Sievers et al. (U.S. Patent No. 5,941,813). Specifically, the Examiner states that Brennan et al. fail to disclose super elastic alloys but that Sievers et al. disclose a cardiac assist device having a super elastic support structure, and that it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use the super elastic material as taught by Sievers.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. §2143.

As required by the M.P.E.P., the Examiner has not set forth a *prima facie* case of obviousness with respect to claims 10-21 as the Examiner has not identified any of their respective limitations as being present in either of the two cited references.

Claims 10-21 either depend on or have a chain of dependency on claim 1 and thus include the limitations of claim 1. As indicated above, the Examiner has not identified any of the limitations of claim 1 as being disclosed or taught by Brennan et al. Accordingly, for at least the reasons presented above by the Applicant with respect to the traversal of the rejection under 35 U.S.C. §102(b) based on Brennan et al., Applicants submit that the Examiner has not set forth a *prima facie* case of obviousness with respect to claims 10-21 as the Examiner has not identified any of their respective limitations as being present in either of the two cited references. Accordingly, the subject matter of claims 10-21 is not unpatentable over Brennan et al. in view of Sievers et al. as Sievers et al. fails to make up for the deficiencies of Brennan et al.

Assuming arguendo that Brennan et al. does disclose all of the limitations of claim 1, the Examiner has not established a *prima facie* case of obviousness at least with respect to claims 12-21. The stated rejection appears to address only the subject matter of claims 10 and 11 which recite, in part,

a support structure comprised of a super elastic material. The Examiner has not identified any of the limitations of claims 12-21 as being disclosed or taught by Sievers et al.

Accordingly, Applicants respectfully request withdrawal of this rejection and allowance of the claims.

**Allowable Subject Matter**

Claims 5 and 6 were objected to as being dependent on a rejected base claim, but were otherwise indicated to be allowable.

Applicants thank the Examiner for the indication of allowance.

**Conclusion**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number CNVG-006.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 11/4/03

By: *Carol M. LaSalle*

Carol M. LaSalle  
Registration No. 39,740

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231